PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86180266
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	

Attorney Docket No.: 048337-330
Mark: BIOSYMULATOR
Application Serial No.: 86180266

REMARKS

This is a Request for Reconsideration in response to the Final Office Action issued December 4, 2014. The Examining Attorney has refused registration of the application on the basis that the mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Applicant respectfully traverses this refusal. Nonetheless, in accordance with TMEP § 1213.08(c), Applicant has entered a disclaimer for the term “biosimulator.” Applicant therefore respectfully requests that the application be accepted for registration on the Principal Register.

The Examining Attorney has based her objections to registration of Applicant’s mark on the grounds that the mark is merely descriptive of the associated goods, arguing that many potential consumers encountering the term will expect the goods to be software that performs biosimulations. On the basis of the Examining Attorney’s position that the Mark is a descriptive, a disclaimer of the properly spelled descriptive term “biosimulator” should obviate the refusal. Applicant has entered such a disclaimer in accordance with TMEP § 1213.08(c), which states that when a mark comprises a word that is misspelled but still must be disclaimed, the Examining Attorney must require a disclaimer of the word in the correct spelling. The mark BIOSYMULATOR is not a real word and contains a “Y” where an “I” would appear in the actual word. Such a disclaimer avoids the concern that registration for the Mark,

which the Examining Attorney considers to be a misspelled version of the term "biosimulation," could prevent others from using the proper spelling of the underlying word. The court in *Miller Brewing Company v. Falstaff Brewing Corp* noted that this concern can be negated by simply requiring the user of a misspelling to disclaim any rights in the proper spelling and sound of the mark as a condition of registration. 208 USPQ 919, 936 n. 21 (D. RI 1980). This practice of disclaiming the properly spelled term for a misspelled word has been generally accepted. For instance, in *In re Omaha Nat'l Corp* ., the Court noted that registration of the mark FIRSTIER, in connection with banking services, would be allowable if the Applicant entered a disclaimer of exclusive rights in the phrase "first tier." 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). Similarly, because Applicant has properly entered a disclaimer of the correct spelling of the term "BIOSIMULATOR," and thus cannot preclude competitors from also using the term, Applicant's mark should be allowed to proceed to registration.

In the alternative, Applicant asserts that the mark BIOSYMULATOR is a telescoped word, which is a subcategory of misspelled words. *See* TMEP § 1213.08(c) ("Marks often comprise words that may be characterized as 'misspelled.' For example, marks may comprise terms that are 'telescoped'"). The mark BIOSYMULATOR is a telescoped mark because it comprises two or more words that share letters. TMEP § 1213.05(a)(i). *See also United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039 (TTAB 2014)(finding that applicant's mark "BeauTV" was likely to cause confusion with opposer's registered trademark "The Beauty Channel," since consumers were likely to understand applicant's mark to represent the telescoped form of the term "Beauty TV"). In particular, Applicant's mark BIOSYMULATOR is a shortened and compounded form of the full title, "Biological Systems Simulator." Each of the three words is shortened and combined to form one distinct compound mark. Therefore, it is clear that the "Y" in Applicant's mark is not used simply in place of an "I" as a novel spelling of the word "simulator" as the Examining Attorney suggests, but instead as a piece of the word "systems." Both of the shortened terms "Bio" and "Sy" are then combined with the end portion of the last term, to make "Bio" "Sy" "Mulator"—i.e. BIOSYMULATOR.

A telescoped mark is considered unitary and therefore no disclaimer of an individual portion of the telescoped word is required. However, if an Examining Attorney considers the telescoped word itself unregistrable, registration may only be allowed with a disclaimer of the telescoped word. TMEP § 1213.05(a)(i). *See also Omaha Nat'l Corp.* , 819 F.2d 1117.

Here, as previously asserted by the Applicant, the mark BIOSYMULATOR is not a descriptive, unregistrable mark because it is a telescoped word with a misspelling that creates a double entendre. *See In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009)(stating that applicant's disclaimer of the words "urban housing" would be acceptable if applicant's proposed mark URBANHOUZING were to be found inherently distinctive, rather than merely descriptive, if applicant's mark would be viewed as having a double entendre based on a misspelling of the mark) ; *In re Tea and Sympathy Inc*., 88 USPQ2d 1062 (TTAB 2008)(finding that the proposed mark THE FARMACY was not merely descriptive of applicant's retail store services featuring herbs and organic products since customers would be likely to perceive the mark as a play on the natural or "farm-fresh" characteristics of applicant's herbs and organic products); *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994)(finding that the proposed mark MufFuns was not merely descriptive because it suggested both muffins and the 'fun' aspect of applicant's food product). Similarly, the unique combination of the three words "Biological," "Systems," and "Simulator" by pushing the terms "System and Simulator" together, creates a double entendre that is distinctive due to its double meaning. For instance, the portion of the mark "SYMULATOR" could refer to either "simulator" or to the combined terms "systems" and "simulator," as applied to Applicant's computer software goods. Because the mark contains a double entendre, it should not be refused registration as merely descriptive. *See* TMEP 1213.05(c).

Moreover, even if the Examining Attorney is not persuaded that the mark creates a double entendre, the application should still be allowed to proceed to registration because the mark contains a unique misspelling and there is a split of authority on the question of whether a misspelling of an otherwise common or descriptive word may be a valid trademark. *See Miller Brewing Company v. Falstaff Brewing Corp.*, 208 USPQ 919, 936 n. 21 (D. RI 1980). For example, the terms "XTRA" and "Alo," for skin cream made from the aloe plant, have been found to be valid trademarks. *See In re Warren Petroleum Corp*., 192 USPQ 405 (TTAB 1976); *Aloe Crème Laboratories Inc. v. Aloe 99, Inc*., 188 USPQ 316 (TTAB 1975).

It is well-settled that the burden is on the United States Patent and Trademark Office to make a *prima facie* showing that the mark in question is descriptive from the perspective of purchasers of Applicant's goods. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc*., 828 F.2d 1567 (Fed. Cir. 1987). Any doubt with respect to the issue of descriptiveness should be resolved in the applicant's behalf. *In re*

Grand Metropolitan Foodservice, Inc., 30 USPQ2d 1974 (TTAB 1994). Because a *prima facie* case has not been made, Applicant respectfully requests that the application be approved for publication.

Because Applicant has responded to all issues raised by the Examining Attorney, Applicant respectfully requests the application be approved for publication. Should the Examining Attorney have any questions, he is invited to contact Applicant's counsel at (202) 585-8220 or (202) 585-8210.

Respectfully submitted,

/KMB/

David L. May
Lauren J. Arnold
Katherine M. Bastian
Nixon Peabody LLP
401 9th Street NW
Suite 900
Washington, DC 20004-2128
P (202) 585-8000
nptm@nixonpeabody.com

ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use BIOSIMULATOR apart from the mark as shown.
SIGNATURE SECTION	
RESPONSE SIGNATURE	/KMB/
SIGNATORY'S NAME	Katherine M. Bastian
SIGNATORY'S POSITION	Attorney of Record, VA bar member
SIGNATORY'S PHONE NUMBER	202-585-8000
DATE SIGNED	03/13/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Mar 13 12:22:09 EDT 2015
TEAS STAMP	USPTO/RFR-208.255.90.221-20150313122209911974-86180266-53052b128d497b8e68c703711a6f104cfac7e5b929b311b695b329101a1c88e8-N/A-N/A-20150313115355941487

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **86180266** has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Attorney Docket No.: 048337-330
Mark: BIOSYMULATOR
Application Serial No.: 86180266

REMARKS

This is a Request for Reconsideration in response to the Final Office Action issued December 4, 2014. The Examining Attorney has refused registration of the application on the basis that the mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Applicant respectfully traverses this refusal. Nonetheless, in accordance with TMEP § 1213.08(c), Applicant has entered a disclaimer for the term "biosimulator." Applicant therefore respectfully requests that the application be accepted for registration on the Principal Register.

The Examining Attorney has based her objections to registration of Applicant's mark on the grounds that the mark is merely descriptive of the associated goods, arguing that many potential consumers encountering the term will expect the goods to be software that performs biosimulations. On the basis of the Examining Attorney's position that the Mark is a descriptive, a disclaimer of the properly spelled descriptive term "biosimulator" should obviate the refusal. Applicant has entered such a disclaimer in accordance with TMEP § 1213.08(c), which states that when a mark comprises a word that is misspelled but still must be disclaimed, the Examining Attorney must require a disclaimer of the word in the correct spelling. The mark BIOSYMULATOR is not a real word and contains a "Y" where an "I" would appear in the actual word. Such a disclaimer avoids the concern that registration for the Mark, which the

Examining Attorney considers to be a misspelled version of the term “biosimulation,” could prevent others from using the proper spelling of the underlying word. The court in *Miller Brewing Company v. Falstaff Brewing Corp* noted that this concern can be negated by simply requiring the user of a misspelling to disclaim any rights in the proper spelling and sound of the mark as a condition of registration. 208 USPQ 919, 936 n. 21 (D. RI 1980). This practice of disclaiming the properly spelled term for a misspelled word has been generally accepted. For instance, in *In re Omaha Nat’l Corp* ., the Court noted that registration of the mark FIRSTIER, in connection with banking services, would be allowable if the Applicant entered a disclaimer of exclusive rights in the phrase “first tier.” 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). Similarly, because Applicant has properly entered a disclaimer of the correct spelling of the term “BIOSIMULATOR,” and thus cannot preclude competitors from also using the term, Applicant’s mark should be allowed to proceed to registration.

In the alternative, Applicant asserts that the mark BIOSYMULATOR is a telescoped word, which is a subcategory of misspelled words. *See* TMEP § 1213.08(c) (“Marks often comprise words that may be characterized as ‘misspelled.’ For example, marks may comprise terms that are ‘telescoped’”). The mark BIOSYMULATOR is a telescoped mark because it comprises two or more words that share letters. TMEP § 1213.05(a)(i). *See also United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039 (TTAB 2014)(finding that applicant's mark “BeauTV” was likely to cause confusion with opposer's registered trademark “The Beauty Channel,” since consumers were likely to understand applicant’s mark to represent the telescoped form of the term “Beauty TV”). In particular, Applicant’s mark BIOSYMULATOR is a shortened and compounded form of the full title, “Biological Systems Simulator.” Each of the three words is shortened and combined to form one distinct compound mark. Therefore, it is clear that the “Y” in Applicant’s mark is not used simply in place of an “I” as a novel spelling of the word “simulator” as the Examining Attorney suggests, but instead as a piece of the word “systems.” Both of the shortened terms “Bio” and “Sy” are then combined with the end portion of the last term, to make “Bio” “Sy” “Mulator”—i.e. BIOSYMULATOR.

A telescoped mark is considered unitary and therefore no disclaimer of an individual portion of the telescoped word is required. However, if an Examining Attorney considers the telescoped word itself unregistrable, registration may only be allowed with a disclaimer of the telescoped word. TMEP § 1213.05(a)(i). *See also Omaha Nat’l Corp. ,* 819 F.2d 1117.

Here, as previously asserted by the Applicant, the mark BIOSYMULATOR is not a descriptive,

unregistrable mark because it is a telescoped word with a misspelling that creates a double entendre. *See In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009)(stating that applicant's disclaimer of the words "urban housing" would be acceptable if applicant's proposed mark URBANHOUZING were to be found inherently distinctive, rather than merely descriptive, if applicant's mark would be viewed as having a double entendre based on a misspelling of the mark) ; *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062 (TTAB 2008)(finding that the proposed mark THE FARMACY was not merely descriptive of applicant's retail store services featuring herbs and organic products since customers would be likely to perceive the mark as a play on the natural or "farm-fresh" characteristics of applicant's herbs and organic products); *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994)(finding that the proposed mark MufFuns was not merely descriptive because it suggested both muffins and the 'fun' aspect of applicant's food product). Similarly, the unique combination of the three words "Biological," "Systems," and "Simulator" by pushing the terms "System and Simulator" together, creates a double entendre that is distinctive due to its double meaning. For instance, the portion of the mark "SYMULATOR" could refer to either "simulator" or to the combined terms "systems" and "simulator," as applied to Applicant's computer software goods. Because the mark contains a double entendre, it should not be refused registration as merely descriptive. *See* TMEP 1213.05(c).

Moreover, even if the Examining Attorney is not persuaded that the mark creates a double entendre, the application should still be allowed to proceed to registration because the mark contains a unique misspelling and there is a split of authority on the question of whether a misspelling of an otherwise common or descriptive word may be a valid trademark. *See Miller Brewing Company v. Falstaff Brewing Corp.*, 208 USPQ 919, 936 n. 21 (D. RI 1980). For example, the terms "XTRA" and "Alo," for skin cream made from the aloe plant, have been found to be valid trademarks. *See In re Warren Petroleum Corp.*, 192 USPQ 405 (TTAB 1976); *Aloe Crème Laboratories Inc. v. Aloe 99, Inc.*, 188 USPQ 316 (TTAB 1975).

It is well-settled that the burden is on the United States Patent and Trademark Office to make a *prima facie* showing that the mark in question is descriptive from the perspective of purchasers of Applicant's goods. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567 (Fed. Cir. 1987). Any doubt with respect to the issue of descriptiveness should be resolved in the applicant's behalf. *In re Grand Metropolitan Foodservice, Inc.*, 30 USPQ2d 1974 (TTAB 1994). Because a *prima facie* case has not been

made, Applicant respectfully requests that the application be approved for publication.

Because Applicant has responded to all issues raised by the Examining Attorney, Applicant respectfully requests the application be approved for publication. Should the Examining Attorney have any questions, he is invited to contact Applicant's counsel at (202) 585-8220 or (202) 585-8210.
Respectfully submitted,

/KMB/

David L. May
Lauren J. Arnold
Katherine M. Bastian
Nixon Peabody LLP
401 9th Street NW
Suite 900
Washington, DC 20004-2128
P (202) 585-8000
nptm@nixonpeabody.com

ADDITIONAL STATEMENTS
Disclaimer
No claim is made to the exclusive right to use BIOSIMULATOR apart from the mark as shown.

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /KMB/ Date: 03/13/2015
Signatory's Name: Katherine M. Bastian
Signatory's Position: Attorney of Record, VA bar member

Signatory's Phone Number: 202-585-8000

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86180266

Internet Transmission Date: Fri Mar 13 12:22:09 EDT 2015
TEAS Stamp: USPTO/RFR-208.255.90.221-201503131222099
11974-86180266-53052b128d497b8e68c703711
a6f104cfac7e5b929b311b695b329101a1c88e8-
N/A-N/A-20150313115355941487